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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,739	01/04/2001	James L. Kroening	97-0506 D1.1	2734

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EXAMINER

ROCHE, TRENTON J

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 03/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,739

Applicant(s)

KROENING ET AL.

Examiner

Trent J Roche

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to communications filed 04 January 2001.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 20-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as disclosed in claims 20-23 is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and **tangible** result." (State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373, 47 USPQ2d at 1601-02.)

Specifically, the claims are directed to a removable medium containing software configuration code, and is thus not necessarily tangibly embodied in a computer system. Thus, Applicants fail to disclose that the language is tangibly embodied and executed by a piece of hardware and that their functions have practical applications which produce useful, concrete, and tangible results under the State Street Formulation.

On this basis, claims 20-23 are rejected under 35 U.S.C. § 101.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No.

09/631,081. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention and recite only obvious differences which would have been obvious to one of ordinary skill in the art at the time of invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Instant claim:

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Application 09/631,081 claim:

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A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. In re Berg, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).

Per claim 1:

6. Claim 1 of Application 09/631,081 as shown in the table below contains every element of claim 1 of the instant application and as such anticipates claim 1 of the instant application.

Application 09/631,081	Instant Application
1. A method of building a custom software configuration, comprising:	1. A method of building a custom software configuration, comprising:
Receiving a plurality of requests for desired software configurations;	Receiving a plurality of requests for desired software configurations;
Identifying at least one baseline configuration corresponding to the desired software configurations;	Identifying at least one baseline configuration corresponding to the desired software configurations;
Comparing the at least one baseline configuration with the desired software configurations;	Comparing the at least one baseline configuration with the desired software configurations;
Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the baseline configuration to generate the desired software configuration	Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the baseline configuration to generate the desired software configuration
Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading a plurality of desired software configurations corresponding to the requested plurality of	Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading a plurality of desired software configurations corresponding to the requested plurality of

desired software configurations.	desired software configurations.
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Claim 1 of the instant application is anticipated by claim 1 of Application 09/631,081 in that claim 1 of the 09/631,081 application contains all the limitations of claim 1 of the instant application. Claim 1 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claim 6:

7. Claim 6 of Application 09/631,081 as shown in the table below contains every element of claim 6 of the instant application and as such anticipates claim 6 of the instant application.

Application 09/631,081	Instant Application
6. A method of building a custom software configuration, comprising: Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration; Identifying at least one software configuration corresponding to at least one of the first desired software configuration and the second desired software configuration, wherein the at least one software configuration is suitable for generating the first desired software configuration and the second desired software configuration, and Storing the software configuration on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.	6. A method of building a custom software configuration, comprising: Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration; Identifying at least one software configuration corresponding to at least one of the first desired software configuration and the second desired software configuration, wherein the at least one software configuration is suitable for generating the first desired software configuration and the second desired software configuration, and Storing the software configuration on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.

Claim 6 of the instant application is anticipated by claim 6 of Application 09/631,081 in that claim 6 of the 09/631,081 application contains all the limitations of claim 6 of the instant application. Claim

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6 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claim 11:

8. Claim 11 of Application 09/631,081 as shown in the table below contains every element of claim 11 of the instant application and as such anticipates claim 11 of the instant application.

Application 09/631,081	Instant Application
11. A method of building a custom software configuration, comprising:	11. A method of building a custom software configuration, comprising:
Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;	Receiving a first request for a first desired software configuration and a second request for a second desired software configuration, the first desired software configuration being different than the second desired software configuration;
Identifying at least one baseline configuration corresponding to at least one of the first desired software configuration and the second desired software configuration;	Identifying at least one baseline configuration corresponding to at least one of the first desired software configuration and the second desired software configuration;
Comparing the at least one baseline configuration with the first desired software configuration and the second desired software configuration	Comparing the at least one baseline configuration with the first desired software configuration and the second desired software configuration
Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the at least one baseline configuration to generate the first desired software configuration and the second desired software configuration, and	Creating a set of changes based on the comparison wherein the set of changes are suitable for combining with the at least one baseline configuration to generate the first desired software configuration and the second desired software configuration, and
Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.	Storing the at least one baseline configuration and set of changes on a removable medium, the removable medium suitable for loading the first desired software configuration and the second desired software configuration.

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Claim 11 of the instant application is anticipated by claim 11 of Application 09/631,081 in that claim 11 of the 09/631,081 application contains all the limitations of claim 11 of the instant application.

Claim 11 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claim 16:

9. Claim 16 of Application 09/631,081 as shown in the table below contains every element of claim 16 of the instant application and as such anticipates claim 16 of the instant application.

Application 09/631,081	Instant Application
16. A method of building a custom software configuration, comprising:	16. A method of building a custom software configuration, comprising:
Receiving a first customer order for a first information handling system and a second customer order for a second information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components and the second customer order including second list of hardware configuration components and a second list of software configuration components, wherein at least one of the first list of hardware configuration components is different from the second list of hardware configuration components, and the first list of software configuration components is different from the second list of software configuration components; and	Receiving a first customer order for a first information handling system and a second customer order for a second information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components and the second customer order including second list of hardware configuration components and a second list of software configuration components, wherein at least one of the first list of hardware configuration components is different from the second list of hardware configuration components, and the first list of software configuration components is different from the second list of software configuration components; and
Storing at least one software configuration on a removable medium, the at least one software configuration suitable for loading at least one of the first list of software configuration components and the second list of software configuration components onto at least one of	Storing at least one software configuration on a removable medium, the at least one software configuration suitable for loading at least one of the first list of software configuration components and the second list of software configuration components onto at least one of

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the first information handling system and the second information handling system.	the first information handling system and the second information handling system.
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Claim 16 of the instant application is anticipated by claim 16 of Application 09/631,081 in that claim 16 of the 09/631,081 application contains all the limitations of claim 16 of the instant application.

Claim 16 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claim 20:

10. Claim 20 of Application 09/631,081 as shown in the table below contains every element of claim 20 of the instant application and as such anticipates claim 20 of the instant application.

Application 09/631,081	Instant Application
20. A removable medium having machine readable instructions stored thereon for computer implemented execution, comprising:	20. A removable medium, comprising:
A software library, including:	A software library, including:
A first software configuration corresponding to a first customer order for a first information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components, the first software configuration suitable for loading on the first information handling system; and	A first software configuration corresponding to a first customer order for a first information handling system, the first customer order including a first list of hardware configuration components and a first list of software configuration components, the first software configuration suitable for loading on the first information handling system; and
A second software configuration corresponding to a second customer order for a second information handling system, the second customer order including a second list of hardware configuration components and a second list of software configuration components, the second software configuration suitable for loading on the second information handling system; and	A second software configuration corresponding to a second customer order for a second information handling system, the second customer order including a second list of hardware configuration components and a second list of software configuration components, the second software configuration suitable for loading on the second information handling system; and
Wherein at least one of the first list of hardware	Wherein at least one of the first list of hardware

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configuration components is different from the second list of hardware configuration components and the first list of software configuration components is different from the second list of software configuration components so that the first software configuration is unsuitable for loading software configuration components on the second information handling system.	configuration components is different from the second list of hardware configuration components and the first list of software configuration components is different from the second list of software configuration components so that the first software configuration is unsuitable for loading software configuration components on the second information handling system.
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Claim 20 of the instant application is anticipated by claim 20 of Application 09/631,081 in that claim 20 of the 09/631,081 application contains all the limitations of claim 20 of the instant application.

Claim 20 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Per claims 2-5, 7-10, 12-15, 17-19 and 21-23:

11. Claims 2-5, 7-10, 12-15, 17-19 and 21-23 of the instant application are further anticipated by claims 2-5, 7-10, 12-15, 17-19 and 21-23, respectively, of U.S. Patent 6,233,731 in that claims 2-5, 7-10, 12-15, 17-19 and 21-23 of the 6,233,731 patent contains all the limitations of claims 2-5, 7-10, 12-15, 17-19 and 21-23, respectively, of the instant application. Claims 2-5, 7-10, 12-15, 17-19 and 21-23 of the instant application are therefore not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trent J Roche whose telephone number is (703)305-4627. The examiner can normally be reached on Monday - Friday, 9:00 am - 6:30 pm.

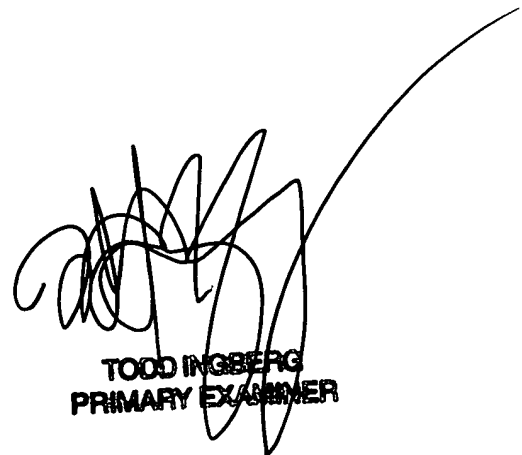
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trent J Roche
Examiner
Art Unit 2124

TJR



TODD INBERG
PRIMARY EXAMINER